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| 10/500,070 | 03/09/2005 | Takeshi Koda | 8048-1044 | 7315 |
| <small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314 | | | <small>7590</small> EXAMINER HASAN, SYED Y | |
| | | | <small>ART UNIT</small> 2621 | <small>PAPER NUMBER</small> |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,070

Applicant(s)

KODA ET AL.

Examiner

SYED Y. HASAN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 - 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 - 34 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION
Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex

IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 18 – 20, 31 – 33 and 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 18 - 20 define "recording medium" with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") while embodied on a tangible computer readable medium, recording medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory class of §101. Rather, "medium" is a form of energy, in the absence of any

physical structure or tangible material. Examiner recommends changing "An information recording medium ..." to "A computer readable information recording medium ...".

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer- readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory.

Claims 31 - 33 define a "computer program" with descriptive material.

A "program" embodying functional descriptive material is neither a process nor a product (i. e. a tangible "thing") and therefore does not fall into one of the four statutory class of 101. Rather a "program" is a form of energy, in the absence of any physical structure or a tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non- statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible readable computer readable media, while at the same time excluding the intangible media such as software, signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim 34 defines "control signal" with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") while embodied on a tangible computer readable medium, recording medium embodying that

same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory class of §101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material. Examiner recommends changing "A data structure including a control signal" to "A computer readable data structure including a control signal".

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 10/500,073 in view of Nishimura et al (US 5897218)

Regarding **claim 18** of this application, claim 20 as discussed above recite all the claimed limitations except for an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams and being recorded in a second area which is different from the first area on said information recording medium.

Here an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams has been recited in the claim for an object data file in copending application 10/500,073. Merely shifting the limitation does not make it unique as shown in re Japiske, 86 USPQ 70 (CCPA 1950)

On the other hand Nishimura et al teaches being recorded in a second area which is different from the first area on said information recording medium (page 14, claim 1)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate being recorded in a second area which is different from the first area on said information recording medium as taught by Nishimura et al in the system of Koda et al in order to provide a separate location for important information.

4. **Claims 19, 20, 22, 24, 26 and 28** of this application are same as and encompasses respectively of copending claims 21, 22, 25, 28, 30 and 32 of Application No. 10/500,073 and, therefore, nonstatutory obviousness- type double patenting rejection is applied.

5. Claims 21, 23 and 31 are rejected on the ground of nonstatutaory obviousness-type double patenting as being unpatentable over claims 23, 26 and 35 respectively of copending Application No. 10/500,073 in view of Nishimura et al (US 5897218)

Regarding **claim 21** of this application, claim 23 as discussed above recite all the claimed limitations except for a third recording device for recording correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams and being recorded in a second area which is different from the first area on said information recording medium and object data file being recorded in a first area on said information recording medium

Here a third recording device for recording correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams has been recited in claim 23 for a first recording device in copending application 10/500,073. Merely shifting the limitation does not make it unique as shown in re Japiske, 86 USPQ 70 (CCPA 1950)

On the other hand Nishimura et al teaches being recorded in a second area which is different from the first area on said information recording medium and file being recorded in a first area on said information recording medium (page 14, claim 1)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate being recorded in a second area which is different from the first area on said information recording medium and file being recorded in a first area on said information recording medium as taught by Nishimura et al in the system of Koda

et al in order to provide a separate location for important information.

Claims 23 and 31 are rejected on the basis of claim 21 above since the difference in the claims are the same as mentioned in claim 21 above

7. Claims 25, 27, 29, 30, 32 and 33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 29, 31, 33, 34, 36 and 37 respectively of copending Application No. 10/500,073 in view of Nishimura et al (US 5897218) and further in view of Murase et al (US 6681077)

Regarding **claim 25** of this application, claim 29 as discussed above recite all the claimed limitations except for an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams and being recorded in a second area which is different from the first area on said information recording medium, object data file being recorded in a first area on said information recording medium and a reproducing device reading information from a first and a second area.

Here an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams has been recited in the claim for an object data file in copending application 10/500,073. Merely shifting the limitation does not make it unique as shown in re Japiske, 86 USPQ 70 (CCPA 1950)

On the other hand Nishimura et al teaches being recorded in a second area which is different from the first area on said information recording medium and file

being recorded in a first area on said information recording medium (page 14, claim 1)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate being recorded in a second area which is different from the first area on said information recording medium and file being recorded in a first area on said information recording medium as taught by Nishimura et al in the system of Koda et al in order to provide a separate location for important information.

The combination of Koda et al and Nishimura et al do not disclose a reproducing device reading information from a first and a second area.

On the other hand Murase et al teaches a reproducing device reading information from a first and a second area (col 7, lines 40 -50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a reproducing device reading information from a first and a second area as taught by Murase et al in the combined system of Koda et al and Nishimura et al in order to know the stream in the area before reproducing it.

Claims 27, 29, 30, 32 and 33 are rejected on the basis of claim 25 above since the difference in the claims are the same as mentioned in claim 25 above.

8. Claim 34 is rejected on the ground of nonstatutaory obviousness-type double patenting as being unpatentable over claim 38 of copending Application No. 10/500,073 in view of Nishimura et al (US 5897218)

Regarding **claim 34** of this application, claim 38 as discussed above recite all the claimed limitations except for an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality

of packets multiplexed on a time axis and the plurality of portion streams and being recorded in a second area which is different from the first area on said information recording medium and object data file being recorded in a first area on said information recording medium

Here an object information file for storing correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams has been recited in claim 38 for an object data file in copending application 10/500,073. Merely shifting the limitation does not make it unique as shown in re Japiske, 86 USPQ 70 (CCPA 1950)

On the other hand Nishimura et al teaches being recorded in a second area which is different from the first area on said information recording medium and file being recorded in a first area on said information recording medium (page 14, claim 1)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate being recorded in a second area which is different from the first area on said information recording medium and file being recorded in a first area on said information recording medium as taught by Nishimura et al in the system of Koda et al in order to provide a separate location for important information.

Information Disclosure Statement

9. The information disclosure statement filed 06/25/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all

other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

10. Claims 18 - 34 would be allowable if amended to overcome the rejection(s) under 35 U.S.C. 101 and double patenting set forth in this Office action including compliance to 37 CFR 1.98(a)(2) for the information disclosure statement as mentioned above.

11. The following is an examiner's statement of reasons for allowance: The present invention is directed to an information recording/reproducing apparatus and method comprising correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on time axis.

Independent claims 18, 25, 27, 29, 30 and 32 - 34 identify the uniquely distinct feature "an object information file for storing, as reproduction control information for controlling the reproduction of said object data file, correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams, said object information file being not multiplexed by the unit of packet and being recorded in a second area which is different from the first area on said information recording medium." The closest prior arts, Ando et al (US Pat. No. 7,346,266), Mori et al. (US Pat. No. 7, 228, 0610), Yagi et al. (US Pat. No. 7, 386, 223), Kawakami et al. (US Pat. No. 6,236,663), either singularly or in combination fail to anticipate or render the above underlined limitations obvious.

Independent claims 21 and 31 identify the uniquely distinct feature "an object

information file for storing, as reproduction control information for controlling the reproduction of said object data file, correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams, said third recording device not multiplexing said object information file by the unit of packet and recording it in a second area which is different from the first area on said information recording medium."

Independent claim 23 identifies the uniquely distinct feature "an object information file for storing, as reproduction control information for controlling the reproduction of said object data file, correspondence definition information which defines a correspondence relationship between a plurality of packets multiplexed on a time axis and the plurality of portion streams, said third recording process not multiplexing said object information file by the unit of packet and recording it in a second area which is different from the first area on said information recording medium."

Reference to prior art mentioned above applies to these features also.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Y. H.
08/01/2008

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621